

based upon document size information and the cover content information received through the interface.

Claim 13 recites a cover authoring method that comprises: (1) receiving size information for a document to be bound into a perfectly bound book having a spine characterized by a width dimension and a height dimension; (2) receiving content information for at least a front region and a spinal region of a cover to be attached to the perfectly bound book; and (3) composing a final content layout for the cover by scaling content received for the front cover region and formatting content received for the spinal region of the cover to accommodate the width and height dimensions of the book spine based upon the received document size information and the received cover content information.

The Examiner has rejected claims 1, 2, 4, 13, 14, and 21-31 under 35 U.S.C. § 102(e) over Michaelis (U.S. 2002/0057453).

In response to Applicants' arguments presented in the Amendment dated March 18, 2004, the Examiner has indicated that (original emphasis):

In response to applicant's arguments that Michaelis fails to disclose the product-by-process method of scaling the front cover content, formatting the spinal region to accommodate the width and height dimensions of the book spine, the examiner has reviewed the claims in further depth, has withdrawn the previous allowable subject matter and has rejected the amended and new claims, since the method of configuring a layout engine by scaling content received, formatting the content, compute a bounding box, setting a height and width related typeface parameter, and composing the final content layout does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 21113). Therefore, it would be obvious to configure the engine layout by any desirable method.

The Examiner, however, has mischaracterized the pending claims as a "method of configuring a layout engine." None of the pending claims recites such a method. The Examiner is requested to review the actual language recited in each of the pending claims.

The Examiner also has mischaracterized the pending claims as product-by-process claims. A product-by-process claim, however, "is a product claim that defines the claimed

product in terms of the process by which it is made" (MPEP §2173.05(p)). Neither of independent claims 1 and 13 is a product-by-process claim.

Claim 1 is a straightforward apparatus claim that recites a cover authoring tool that comprises an interface and a cover content layout engine. To be a product-by-process claim, the body of claim 1 would have to recite steps in the process of making the cover authoring tool; but that is not the case.

Claim 13 is a straightforward method claim that recites a cover authoring method that comprises various steps in a process of authoring a cover. To be a product-by-process claim, preamble of claim 13 would have to recite some "product" and the body of claim 13 would have to recite steps in a process of making that "product"; but that is not the case.

Since neither claim 1 nor claim 13 is a product-by-process claim, the Examiner's failure to consider all of the features recited in claims 1 and 13 is improper. To establish proper rejections under 35 U.S.C. § 102, the Examiner must consider all of the features recited in claims 1 and 13. In any event, each of claims 1 and 13, however, is patentable over Michaelis for at least the following reasons.

Michaelis fails to teach or suggest anything about a cover authoring tool that comprises a cover content layout engine configured to compose a final layout for the cover by scaling front cover content and formatting content received for the spinal region of the cover to accommodate the width and height dimensions of the book spine based upon document size information and cover content information received through the interface, as recited in claim 1. Michaelis also fails to teach or suggest anything about a cover authoring method that comprises composing a final content layout for the cover by scaling content received for the front cover region and formatting content received for the spinal region of the cover to accommodate the width and height dimensions of the book spine based upon the received document size information and the received cover content information.

In Michaelis' approach, the page size and the cover size for a book are predetermined for a given book title. Michaelis' system prints an image on the cover of a given book at a position that is shifted laterally by an amount needed to accommodate the slight difference between the measured caliper for the given book and a pre-stored nominal caliper value for the particular book title corresponding to the given book (see, e.g., ¶ [0019]). That is, Michaelis' system laterally shifts cover images slightly to the left or right based solely on the slight difference between the measured caliper for the given book and a pre-stored nominal

caliper value for the particular book title. Therefore, Michaelis' system does not scale content received for the front cover region, as recited in claims 1 and 13.

In addition, Michaelis does not even hint that his system formats content received for the spinal region of the cover to accommodate the width and height dimensions of the book spine. Indeed, Michaelis' system adjusts the cover printing process based solely on the slight difference between the measured caliper for the given book and a pre-stored nominal caliper value for the particular book title. Therefore, Michaelis' system does not even consider the height dimension of the book spine when adjusting the cover printing process.

For at least these reasons, the Examiner's rejection of independent claims 1 and 13 under 35 U.S.C. § 102(e) over Michaelis now should be withdrawn.

Claims 2, 4, 21-26 incorporate the features of independent claim 1 and claims 13, 14, and 27-31 incorporates the features of independent claim 13. Therefore, claims 2, 4, and 21-26 are patentable over Michaelis for at least the same reasons explained above.

B. Claims 20 and 32-36

Claim 20 is an independent claim and claims 32-36 depend from claim 20.

Independent claim 20 recites a bookbinding system that comprises a cover authoring tool that comprises an interface configured to receive content information for at least a front region and spinal region of the cover, and a cover content layout engine configured to compose a final content layout for the cover by scaling content received for the front cover region and formatting content received for the spinal region of the cover to accommodate the width and height dimensions of the book spine based upon received document size information and received cover content information. Claim 20 also recites that the bookbinding system comprises a cover binder configured to attach the cover to the text body.

The Examiner has rejected claim 20 under 35 U.S.C. § 102(b) over Kosasa (U.S. 5,735,659). In this rejection, the Examiner simply copied verbatim the arguments presented in the first Office action dated January 9, 2004. In particular, the Examiner has asserted that:

Kosasa et al. discloses in Fig. 1-2A, a bookbinding system comprising a sheet composer configured to format a document to be bound (202); a sheet binder (203) configured to form a text body of two or more sheets having an exposed spine characterized by dimensions; a cover authoring tool comprising an interface (306) configured to receive size information and

content information for a cover, a cover content layout engine (317) configured to compose a final content layout for the cover including the spinal content to accommodate the dimensions for the book spine and cover content (col. 9, lines 44-58); and a cover binder (203) configured to attach the cover to the text body.

Contrary to the Examiner's assertion, however, Kosasa does not teach or suggest anything about a cover binder configured to attach to a text body a cover having a front content region and a spinal content region, as recited in claim 20. Instead, Kosasa merely discloses a binding apparatus that is configured to bind a set of sheets with a length of binding tape 77 that is applied to the spine of the sheet set S1, as shown in FIG. 2B (see, e.g., col. 4, line 57, through col. 5, line 5).

In addition, Kosasa fails to teach or suggest anything about a cover authoring tool that includes an interface configured to receive content information for at least a front region of a cover and a cover content layout engine configured to compose a final content layout for the cover by scaling the received front cover content, as now recited in claim 20. Indeed, since Kosasa's system does not handle covers with front content regions, there is no need whatsoever for Kosasa's system to receive content information for a front region of such a cover or to scale the received front cover content.

To the extent that the Examiner has based his rejection of claim 20 on a belief that claim 20 can be properly examined as a product-by-process claim, the Examiner's rejection of claim 20 should be withdrawn because claim 20 clearly is not a product-by-process claim. Instead, claim 20 is a straightforward apparatus claim that recites a bookbinding system that comprises a sheet composer, a sheet binder, a cover authoring tool, and a cover binder. To be a product-by-process claim, the body of claim 20 would have to recite steps in a process of making a bookbinding system; that that is not the case.

In the Response to Arguments section of the Office action, the Examiner did not address Applicants' arguments regarding independent claim 20. The Examiner is requested to address Applicants' arguments in any subsequent rejection of independent claim 20.

For at least the reasons explained above, the Examiner's rejection of independent claim 20 under 35 U.S.C. § 102(b) over Kosasa now should be withdrawn.

Claims 32-26 incorporate the features of independent claim 20 and therefore are patentable over Kosasa for at least the same reasons.

III. Claim rejections under 35 U.S.C. § 103

A. Claim 3

Claim 3 incorporates the features of independent claim 1.

The Examiner has rejected claim 3 under 35 U.S.C. § 103(a) over Michaelis in view of Carlson (WO 01/00423).

Carlson, however, does not make up for Michaelis' failure to teach or suggest a cover authoring tool comprising a cover content layout engine configured to compose a final content layout for the cover by scaling front cover content and formatting spinal region content to accommodate the width and height dimensions of the book spine based upon document size information and cover content information received through an interface, as recited in claim 1. Indeed, Carlson's system does not receive any cover content whatsoever. Instead, a user must add cover content manually using a separate system (see, e.g., page 17, lines 9-15).

Therefore, for at least the reasons explained above, the Examiner's rejection of claim 3 under 35 U.S.C. § 103(a) over Michaelis in view of Carlson now should be withdrawn.

B. Claims 5-7, 15, and 16

The Examiner has rejected claims 5-7, 15, and 16 under 35 U.S.C. § 103(a) over Michaelis in view of Tonkin (U.S. 6,616,702).

Claims 5-7 incorporate the features of independent claim 1, and claims 15 and 16 incorporate the features of independent claim 13.

1. Claims 5-7

Tonkin does not make up for Michaelis' failure to teach or suggest a cover authoring tool that comprises a cover content layout engine configured to compose a final content layout for the cover by formatting content received from the spinal region of the cover to accommodate the width and height dimensions of the book spine based upon document size information and cover content information, as recited in claim 1. Indeed, Tonkin's system

does not receive any spinal cover content and, therefore, Tonkin does not even hint that his system could be configured to format content received for the spinal region of the cover to accommodate the width and height dimensions of the book spine.

2. Claims 15 and 16

Tonkin does not make up for Michaelis' failure to teach or suggest a cover authoring method that comprises composing a final content layout for the cover by formatting content received for the spinal region of the cover to accommodate the width and height dimensions of the book spine based upon received document size information and received cover content information, as recited in claim 13. Indeed, Tonkin's system does not receive any spinal cover content and, therefore, Tonkin does not even hint that his system could be configured to format content received for the spinal region of the cover to accommodate the width and height dimensions of the book spine.

3. Conclusion

For at least the reasons explained above, the Examiner's rejection of claims 5-7, 15, and 16 under 35 U.S.C. § 103(a) over Michaelis in view of Carlson now should be withdrawn.

C. Claims 9-12

Claims 9, 11, and 12 incorporate the features of independent claim 1, and claim 10 is an independent claim.

The Examiner has rejected claims 9-12 under 35 U.S.C. § 103(a) over Michaelis in view of Kosasa.

Regarding claims 9, 11, and 12, Kosasa does not make up for Michaelis' failure to teach or suggest a cover authoring tool that comprises a cover content layout engine configured to compose a final content layout for the cover by scaling front cover content, as recited in claim 1. Indeed, as explained above in connection with independent claim 20,

Kosasa's system does not handle a book cover having a front content region. For this reason, Kosasa's system does not receive any content whatsoever for a front region of such a cover.

Claim 10 recites a cover authoring tool that comprises a cover content layout engine that is configured to select typeface parameter values for spinal text content consisting of a number of characters based at least in part upon the number of characters of spinal text content and the height and width dimensions of the book spine. As acknowledged by the Examiner, Kosasa's system does not select typeface parameter values for spinal text content based at least in part upon the number of characters of spinal text content and the height and width dimensions of the book spine. However, in yet another improper effort to avoid consideration of all of the features recited in the claims, the Examiner has asserted that (original emphasis):

In regards to claims 10 and 12, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, typeface parameter is capable of being selected for a stretch font variation, and capable of being based upon the number of characters of the spinal content, height and width dimensions of the book spine.

Neither claim 10 nor claim 12, however, recites any assertions of "intended use". Claim 10 recites a cover authoring tool that comprises a cover content layout engine that is configured to select typeface parameter values for spinal text content consisting of a number of characters based at least in part upon the number of characters of spinal text content and the height and width dimensions of the book spine. Claim 12 recites that the cover authoring tool comprises a cover content layout engine that is configured to select a typeface parameter value for a stretch font variation selected from the group consisting of a regular font face, a condensed font face, an expanded font face, and multiple master typeface.

None of the systems described in Michaelis and Kosasa includes a cover content layout engine that is configured to perform the functions respectively recited in claims 10 and 12. Indeed, the systems described in Michaelis and Kosasa would require significant modification to perform such functions. However, neither Michaelis nor Kosasa teaches or

suggests anything that would have led one of ordinary skill in the art to modify any of the systems described in Michaelis and Kosasa in such a way.

In addition, the Examiner has improperly extended the guidelines on which his assertions are based to the bodies of claims 10 and 12. In particular, MPEP § 2111.02 provides the following guidelines regarding recitations of "intended use" in the claims (emphasis added):

If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim.

...

During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art.

That is, the Examiner's assertions regarding the recitation of intended use in a claim applies only to those recitations of intended use that appear in the preamble, not to recitations of intended use that appear the body of the claim. In any event, neither the preambles nor the bodies of claims 10 and 12 include any assertions of "intended use".

For at least the reasons explained above, the Examiner's rejection of claims 9-12 under 35 U.S.C. § 103(a) over Michaelis in view of Kosasa now should be withdrawn.

IV. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

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